

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB OCT. 29, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Jurassic Stone Company  
v.  
Solnhofen Natural Stone, Inc.

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Cancellation No. 25,354

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Edward A. Pennington of Morgan & Finnegan for Jurassic Stone Company

Veronica Colby Devitt of Limbach & Limbach for Solnhofen Natural Stone, Inc.

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Before Simms, Quinn and Walters, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Jurassic Stone Company (petitioner), a partnership of Albert Gregory and Jura Marble Suppliers (JMS), seeks cancellation of Reg. No. 1,753,923, issued February 23, 1993 (Section 8 affidavit filed) for the mark SOLNHOFEN for natural building stone, owned by Solnhofen Natural Stone, Inc. (respondent), a California corporation. The registration issued pursuant to the provisions of Sec. 2(f)

of the Act, 15 USC Sec 1052(f).<sup>1</sup> In the petition for cancellation, petitioner asserts that since August 1994 it has been importing and selling masonry materials including "solnhofen stone," which goods are of a related nature to respondent's products. Petitioner asserts that because "Solnhofen" is a common term used to describe or identify a type of product, which petitioner has a valid and legal right to use, respondent's mark is primarily geographically descriptive of respondent's goods. Further, petitioner charges that the registered mark has not become distinctive of respondent's goods because there is no customer recognition of this term as a mark identifying only respondent's goods. Finally, petitioner charges that the registration was fraudulently obtained because respondent, as applicant, stated that it was the sole and exclusive user of this term in order to establish acquired distinctiveness, when in fact others had been using this term to identify a type of product rather than a single source. Petitioner asserts that statements made in the application were knowingly false and that they were made with the intent to induce this Office to grant a registration.

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<sup>1</sup> In the original application, filed April 16, 1992, respondent indicated that "Solnhofen" is the name of a village in Germany within the general vicinity of which the goods are quarried. In the original application, respondent also asserted that the mark had become distinctive as a result of substantially exclusive and continuous use of the mark by applicant in commerce for the five years preceding the filing date of the application. The

In its answer, respondent has denied the essential allegation of the petition.

The record of the case consists of testimony (and exhibits) submitted by both parties, as well as portions of printed publications (technical journals) relied upon by petitioner's notices of reliance; and the registration file. The parties have submitted briefs and an oral hearing was held.

#### Petitioner's Record

According to petitioner's record, petitioner is a partnership of Mr. Albert Gregory and the export company JMS, an affiliation of seven German stone quarrying companies. Petitioner was formed in April 1995. Petitioner sells Jura limestone and what it has characterized as "solnhofen" or Solnhofen stone (we shall use the term with an initial capital), sometimes called slate limestone or natural cleft stone. Solnhofen stone is hand quarried and petitioner's sales of this stone are around \$50,000-\$60,000 annually. Approximately one percent of its sales are the Solnhofen stone, most of which is used for flooring purposes. Petitioner sells its goods by way of trade shows and trade publications.

Concerning the significance of the term Solnhofen, Mr. Gregory testified as follows, at 100, 101-102, 114, 116-117:

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registration, which recites dates of use of 1984, issued under

Q. And you mentioned before that the Jura limestone that you sell is a marble produced in the Eichstatt area. Is Solnhofen, what you've described as Solnhofen stone the slate limestone that is also produced in the Eichstatt area?

A. Well, it's Eichstatt Solnhofen, that whole area, which is probably 25 to 30 miles or something like that, in a [sic] that whole area, Solnhofen, the name of one town, and Eichstatt the name of another town.

Q. So is it your position that Solnhofen describes a geographic region or a type of stone?

A. It's a geographic region, and a type of stone, probably named for the geographic region.

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Q. Okay. If Solnhofen describes a type of stone, is that type of stone available in other places of the world other than near Solnhofen?

A. Not that I am aware of. That's the area of the world where it's quarried.

Q. When did you first hear of Solnhofen stone?

A. About, I would believe [']91, while I was working with Harold Vogel, Wood & Stone, as their sales estimator. And it might have been even [']90, because I was also in the office and in the shop during those initial periods.

Q. And did Wood & Stone carry a Solnhofen stone?

A. Yes.

Q. And do you know who the producer or fabricator of the stone was?

A. I believe they bought it from one of the Sheffield companies, but I'm not sure which one—

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Q. Do you—I believe that you need to use the term Solnhofen to sell any product, any of your products?

A. The Solnhofen stone, as a Solnhofen limestone, yes, because that's what it's known as, and that's what I've always known it as.

Q. Do your customers specify Solnhofen limestone?

A. Some of them will request, if we go back in,

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the provisions of Sec. 2(f) of the Act.

Jack T. Irwin will ask for the Solnhofen stone, meaning that he wants the--Jack T. Irwin is also the--actually I take that back. Mickey Irwin has the one that I talk to and requested it. I think Jack had probably died by then, because it was his father's company.

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Q. Returning now to your company, Jurassic Stone Company's use of the term Solnhofen, do you use that term on any labels?

A. Yes, for Solnhofen stone.

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Q. Do you use the term Solnhofen on cartons?

A. Yes, again, as an attached label on the cartons.

Q. And it's a separate label that is attached to the cartons?

A. Right.

Q. And is that label different from the label that is on the product itself?

A. Occasionally. If it's on a sample, the sample might just include our address and everything with just it. If it's a carton for resale it might just say Jurassic Stone, Solnhofen stone, natural cleft.

Mr. Gregory also testified that third parties have used the term Solnhofen in connection with their sales of stone. Dep., 120, 121.

Petitioner also took the testimony of Mr. Harold Vogel, a natural stone consultant. According to his testimony, Solnhofen is the name of the town, in southern Bavaria, near where he grew up, known for its limestone quarries.

Q. Is Solnhofen known for anything besides its stone quarries?

A. Is it known for anything else? Well, I mean, this is what put it on the map is the material, the material is not only quarried in Solnhofen. It's quarried in that area, in the Solnhofen area. I'd say within about a 10 mile radius of Solnhofen there are probably 20 or 30 quarries where the same

type of material is quarried and that's all called Solnhofen.

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Q. I'll hand you what the court reporter has marked Vogel 3. Can you identify that stone?

A. Yes. That's a Solnhofen stone.

Q. And how do you know it's Solnhofen stone?

A. Characteristic of Solnhofen stone is that it is very uniform in hardness. That's why up until 1940 it was used worldwide, including the United States, for lithography because it was the only stone totally uniform in hardness. In other words, you could etch into it and the depth of the etching would be uniform all the way through. Okay.

A characteristic of the Solnhofen stone is dendrite in there. Dendrite is a carbon intrusion into the layers. If you put it on a machine and grind this layer off, you come down to a very uniform stone. All fossils or dendrites are always in the surface only. They don't go through the material.

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Q. Can you describe that process, how it's done?

A. Well, the material is a layered material. and the cycles of layers were very regular. There's a variation in thickness of layers that goes from approximately a 16<sup>th</sup> of an inch to approximately 2 inches in thickness. That's a standard, standard on this material here, when you quarry that, it's all quarried by hand. It's all done by hand.

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Q. Is this stone quarried anywhere outside of, let's say, a 10 mile radius of Solnhofen?

A. Not that I know of. I mean, outside that region? I mean, if I say 10 miles, I say approximately ten miles. If you say, I find one that's 12 miles away, that's possible too. But outside that region, no. It's typical for that region.

Q. And how long has Solnhofen stone been quarried out of these quarries in Germany?

A. Well I know from my days in school that the Romans were using it. So I would say like 2,000 years. The Romans they occupied part of Germany if you remember your school days and they build a wall there to keep whatever the Huns or whatever you call them, the barbarians out. And that wall actually went

right across the Jurassic mountain range,  
near within about 3 or 4 miles of that area.  
And they used a lot of that stone in that  
wall too because it's there.

Vogel dep., 12, 16, 17, 18. Mr. Vogel testified that the stone was first imported by his company (Wood and Stone) in November 1980 (dep., 30-31). While this stone was for a time referred to as natural cleft, for ease of pronunciation, it was then Solnhofen stone, the original name. His company sold Solnhofen stone from 1980 to 1994. Dep., 48. Mr. Vogel testified that to him "Solnhofen natural stone" is a particular type of stone. Dep., 59.

Mr. Gerhard Ruf, the managing director of JMS, also testified that Solnhofen stone, which is distinctive and recognizable, has been quarried in the Solnhofen area of Germany since Roman times. Further, he stated that the JMS companies have used Solnhofen to describe stone since prior to 1992, and to describe stone sold in the United States. Ruf dep., 31, 32-33, 36. Invoices were made of record reflecting sales in United States.

Another witness, Mr. Ludwig Miehling, the export sales director of a German company called Niefnecker, testified that in December 1990 Solnhofen stone was sold in San Francisco. Like the other witnesses called by petitioner, Mr. Miehling testified that Solnhofen limestone describes a certain kind of material that is produced and distributed by many companies in the Solnhofen area. Dep., 42. He also

testified concerning an August 1989 sale to a Florida company. Five to 10 large containers of Solnhofen stone were shipped to this country in 1996. Mr. Miehling testified that about one percent of his exports are to the United States. He testified that his first sale to this country was in 1989 (dep., 102) and that sales have been made every year since that time. Dep., 102, 109. Finally, he testified that respondent was aware in February 1990 that Niefnecker was using the term Solnhofen as of that time.

Petitioner has also relied upon a substantial number of printed publications and other publicly available materials such as reference works and technical publications. For example, petitioner has made of record an article from a 1972 Journal of Geophysical Research entitled "Triaxial Stress Behavior of Solenhofen Limestone..." Another reference to Solnhofen limestone, in the sense of limestone from Solnhofen, is excerpted below:

...These rocks [limestone quarried since the Stone Age for roof and floor tiles]--known as the Solnhofen or Solnhofen Limestone, after the small town of Solnhofen--are also famous for their fossils.

Localities of the Jurassic: The Solnhofen Limestone of Germany, petitioner's notice of reliance, item 2.

#### Respondent's Testimony

Respondent took the testimony of Mr. Gunther Kleber, a former managing director of JMS. He testified that, by



agreement, JMS could not sell its stone to customers in the United States until 1994, unless all JMS members agreed to the contrary. Dep., 40-41, 74. However, on cross-examination, Mr. Kleber testified that individual members of JMS could sell their products in the United States. Dep., 75. Mr. Kleber left the employment of JMS in 1990. Dep., 56.

Respondent also took the testimony of Mr. Detlev Wolske, its president and minority shareholder.<sup>2</sup> Founded in 1984, respondent now has offices in San Francisco and New York. Respondent primarily sells various colors of Jura stone, which its calls "Solnhofen stone." Mr. Wolske testified that when respondent began selling its products in this country in 1984, he was not aware of others using the term Solnhofen. Respondent currently distributes its products through Architectural Product Group (APG). Respondent's customers are the architectural design community as well as dealers and distributors of floor coverings, and tile contractors. Respondent targets hotels and restaurants and has done stone installations at malls, office buildings, universities and hospitals. Mr. Wolske testified that respondent's first major installation in this country was in San Francisco in the mid-1980s. Respondent has promoted its goods by means of press releases, industry

trade shows, and, for a time, by advertisements in trade magazines.

With the exception of respondent's Solnhofen greenstone, which is quarried near Westphalia in northern Germany, all of respondent's Solnhofen stone is quarried near the town of Solnhofen. Dep., 65. Mr. Wolske did testify, however, that other companies quarry stone from the Solnhofen area. Dep. 68, 241. When asked what the Solnhofen name means to potential purchasers, Mr. Wolske testified, at 72:

Q. Is the Solnhofen name associated with lithostone?

A. Yes.

Q. Is there any other area for which the Solnhofen name or any other area which the Solnhofen name is associated with a particular type of stone besides the lithostone?

A. Well, it's associated with the fossils found.

Q. Which fossils?

A. We have the--in the period the quarries formed, during that period, a lot of animals, if I can say, fish, et cetera, got embedded in the layers of the quarry, and when we quarry, we find these fossils, these fish fossils, all kinds of fossils, and that's what the name Solnhofen is associated with, also.

Mr. Wolfke testified that in 1989 he became aware of the Niefnecker company's use of the name "Solnhofer" in connection with limestone in an advertisement in a trade publication distributed in this country (Stone World). Dep., 161, 260. Respondent then sought information from

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<sup>2</sup> The majority shareholder is Solnhofer Portland-Zementwerke (SPZ). SPZ is a German cement factory.

Niefnecker by way of an inquiry card and received information and price quotes from Niefnecker. Mr. Wolske testified, at 164:

- Q. After receiving the price quotes, did your company have any further contact with Niefnecker.
- A. Well, that was then--let me think a little bit timewise. We later on then registered our trademark, and I remember Niefnecker continuing their advertising, and obviously it started or it continued to bother us, and we then decided to write them.
- Q. Did someone from your company write to Niefnecker?
- A. We had an attorney write at that time.

On cross-examination, Mr. Wolske was asked about the significance of the term Solnhofen in this country.

- Q. Do you ever have customers ask you what Solnhofen is? When you market your product as Solnhofen greenstone, has anybody ever said what does Solnhofen mean or --
- A. They may sometimes ask me what Solnhofen stands for.
- Q. Do you tell them?
- A. I tell them, yeah.
- Q. Do you tell them it's a village in Germany?
- A. Yeah.
- Q. So if you told them that Solnhofen is a village in Germany and you're selling them Solnhofen greenstone, wouldn't they get the idea that this greenstone comes from Solnhofen?
- A. I don't think so because what they know in the U.S. is that Solnhofen is my trademark, but they don't associate it with a village in Germany unless they maybe are dealing with fossils that they are really knowledgeable about, that Solnhofen is a place where you find fossils or where the lithostones come from.

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- Q. You keep saying, "Where? In Germany?" And again, I question you. Do you believe there is a difference between what people know and

understand in Germany versus what people know and understand in the United States when it comes to--

A. Yes. There is a difference.

Q. What is that difference? Are you saying people in the--

A. That Solnhofen in Germany is known as a--may be known as a village and that Solnhofen in the United States is my trademark.

Q. Well, what if people in the United States knew that the stones that you sell come from the village of Solnhofen? Does that change your position?

A. What position?

Q. You seem to be saying that over here people think of Solnhofen merely as your trademark, whereas in Germany, they think of it as a name of a town.

Do you think it would make any difference to your case if people over here understood Solnhofen to be a German town?

A. Yes, because that's not what it is.

Q. It's not a German town?

A. No. What they refer to in the United States, they don't know Solnhofen in Germany is a village. Only the ones perhaps who deal with fossils or with lithostones may know that in the U.S., but I don't know.

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Q. So far as you know, your customers have not been told about the fact that Solnhofen is a village in or near where your stones are quarried; is that correct?

A. Well, if they ask us, we tell them. If they don't ask us, we don't tell them.

Wolske dep., 188, 193-194, 274. Mr. Wolske testified that respondent did ask Niefnecker to describe its goods as limestone from Solnhofen, a request which was apparently honored for a short period of time.

Respondent's Ex. 26 is a brochure, made of record during the Wolske testimony, which discusses "the ancient limestone beds...[of] the Solnhofen quarry."

The Romans may have been the first to appreciate the buried treasure of Solnhofen limestone. 1800 years ago, Roman soldiers, garrisoned in what is now Bavaria, used Solnhofen stone in their public baths for its remarkable heat conduction.

One of respondent's exhibits (Ex. 52), a reprinted article from the October-November 1991 Dimensional Stone magazine, contains the following about "Solnhofen Stone from Germany":

Some building materials are like shooting stars; they are introduced into the market, achieve a short-lived popularity and disappear. Other building materials last through political eras, wars, upheavals and even beyond the demise of great civilizations. Solnhofen stone is such a material. Its first recorded use was during Roman times, and today the material is enjoying a popular renaissance as one of the world's favorite paving stones.

#### HISTORY

Looking back 1,800 years to the time of the first Roman garrisons in Germany, we find that baths were built for the military. These baths were very much like today's modern health clubs; in them, men gathered to bathe, to play sports and to "network." The tiles in the pools and surrounding rooms of these Roman "health spas" were made from locally quarried Solnhofen Stone, which was known for its density, fine grain and resistance to water penetration...

#### Arguments of the Parties

Briefly, petitioner argues that it imports into this country a variety of building stones including those known in the trade as Solnhofen stones, quarried from the Solnhofen region of Germany. According to petitioner,

Solnhofen is well known in the building stone industry for its quarries and the stone that comes from those quarries. Petitioner argues that the term is primarily geographically descriptive, without secondary meaning because others were selling and advertising similar stone under a similar name and because respondent's activities under the asserted mark were insufficient to establish secondary meaning.

Petitioner also contends that the registration was obtained fraudulently. We note that petitioner argues in its brief that the asserted mark is descriptive and generic. Suffice it to say that we believe that these issues were not adequately pleaded in the petition for cancellation, and we do not believe that respondent was placed on notice that these issues were the subject of trial.<sup>3</sup>

Respondent, on the other hand, contends that petitioner has failed to produce sufficient evidence that the relevant customers (conceded to be architects, "specifiers," builders and distributors) would perceive Solnhofen to be geographically descriptive; that the evidence offered by petitioner contains self-serving opinions and is otherwise irrelevant; that the third-party and other uses of Solnhofen

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<sup>3</sup> It appears from the testimony in this case that respondent is also using the term Solnhofen to identify a German greenstone that is quarried in northern Germany, hundreds of miles from Solnhofen. However, petitioner has not pleaded, and we will therefore not decide, the issue of primary geographic deceptive misdescriptiveness of the term Solnhofen used in connection with these goods (see Sec. 2(e)(3) of the Act).

relied on by petitioner are sporadic, *de minimis*, infringing and "purely geographically descriptive" (brief, 33); and that respondent's use to support acquired distinctiveness was "substantially" exclusive. Respondent also maintains that the German town of Solnhofen is obscure and virtually unknown in this country, except within certain specialized fields unconnected to the building stone industry.

Respondent also contends that it committed no fraud in the application process.<sup>4</sup> Finally, respondent argues that others are free to use Solnhofen in a purely geographical sense. Respondent does acknowledge that the record contains some evidence (letters to potential customers beginning in 1983, for example) of use of the term Solnhofen in this country by others such as the Niefnecker company.<sup>5</sup>

Respondent contends, however, that some of the uses were after respondent commenced use in this country.

#### Discussion and Opinion

In order for registration to be refused (or cancelled) under Section 2(e)(2) of the Trademark Act, it is necessary to establish that the primary significance of the mark

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<sup>4</sup> Some of the particular allegations of fraud addressed by the parties (e.g., use by respondent of the term for goods not coming from Solnhofen) were not pleaded "with particularity" by petitioner, and we have not considered them.

<sup>5</sup> See brief, 14, 16, 31-32. Concerning objections raised in the parties' briefs, we have excluded respondent's search report (Ex. 75) relied on by notice (see *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992)). To the extent that some of the evidence relied on may be considered to be directed to geologists,

sought to be registered (or cancelled) is the name of a place generally known to the relevant public and that the relevant public would make a goods/place association, that is, believe that the goods for which the mark is sought to be registered (or cancelled) originate in that place. See *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988), citing *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987). Provided that these conditions are met, and the goods come from the place named by or in the mark, the mark is primarily geographically descriptive.

Moreover, where there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named by the term is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed from the fact that the goods come from the geographical place named in the mark. See, e.g., *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 850 (TTAB 1982).

After careful consideration of this record, we agree with petitioner that the record demonstrates that the term Solnhofen is the name of a geographic place known to the relevant public (the stone building industry, architectural designers, etc.), and that, because respondent's Solnhofen

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geophysicists and paleontologists and not the relevant customers



stones come from that place (with the exception of the Solnhofen greenstone), the registered mark is determined to be primarily geographically descriptive under Sec. 2(e)(2) of the Act. While it might be true that the German town of Solnhofen is not well known to the *general* public in this country, we believe that this record adequately demonstrates that the term is known to the relevant class of purchasers involved in this case. Cf. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, *supra*, and cases cited therein. In addition, respondent in its initial application recognized, by its claim of acquired distinctiveness, that Solnhofen was not inherently distinctive. The term should be freely available to all competitors who quarry and sell stone from the Solnhofen region.

Furthermore, concerning the question of acquired distinctiveness, the record amply demonstrates that the primary significance of the term Solnhofen is not and was not (at the time of registration) respondent, but the town and the stones that come from there, regardless of particular source. Moreover, respondent did not, at the time of registration, and does not have substantially exclusive use of this term so as to justify registration under Sec. 2(f). The testimony and exhibits show sales and advertising in this country of Solnhofen stone by the

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herein, we have given this material appropriate weight.

Niefnecker company since at least 1979, by Wood and Stone since 1980, and by the German quarrier Stiegler since 1983. See *Levi Strauss & Co. v. Genesco, Inc.*, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.") Finally, the publications made of record show that the trade press used Solnhofen, not as respondent's trademark, but rather to refer to the town, its quarries and stone which came from there, regardless of particular source.

With respect to the issue of fraud, we note that petitioner has only spent two (out of 42) pages of its brief devoted to this issue. While we have considered petitioner's arguments, suffice it to say that, on this record, we believe that, at the time of registration, respondent's statement in the application that it was entitled to registration on the basis of acquired distinctiveness was not knowingly false, keeping in mind that one must prove fraud by clear and convincing evidence of an intent to mislead this Office. Respondent may have reasonably believed that it was entitled to registration on

the basis of substantially exclusive and continuous use of the term Solnhofen in this country.

Decision: The petition for cancellation is granted in part and denied in part; the registration will be cancelled in due course.

R. L. Simms

T. J. Quinn

C. E. Walters  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board